

THIS OPINION WAS NOT WRITTEN FOR PUBLICATION

The opinion in support of the decision being entered today (1) was not written for publication in a law journal and (2) is not binding precedent of the Board.

Paper No. 14

UNITED STATES PATENT AND TRADEMARK OFFICE

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BEFORE THE BOARD OF PATENT APPEALS  
AND INTERFERENCES

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Ex parte YOSHIO NAKANO  
and  
DON ZEWIN

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Appeal No. 98-0979  
Application No. 08/517,909<sup>1</sup>

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ON BRIEF

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Before COHEN, STAAB, and NASE, Administrative Patent Judges.  
NASE, Administrative Patent Judge.

DECISION ON APPEAL

This is a decision on appeal from the examiner's final rejection of claims 1 through 20, which are all of the claims pending in this application.

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<sup>1</sup> Application for patent filed August 22, 1995.

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Application No. 08/517,909

We REVERSE.

BACKGROUND

The appellants' invention relates to a combined dice and card game. Claim 1 is representative of the subject matter on appeal and a copy of claim 1, as it appears in the appendix to the appellants' brief, is reproduced below.

Claims 1 through 20 stand rejected under 35 U.S.C. § 112, second paragraph, as being incomplete for omitting essential steps, such omission amounting to a gap between the steps.

Claims 1 through 20 stand rejected under 35 U.S.C. § 112, first paragraph, as based on a disclosure which is not enabling.

Rather than reiterate the conflicting viewpoints advanced by the examiner and the appellants regarding the above-noted rejections, we make reference to the examiner's answer (Paper No. 11, mailed June 19, 1997) for the examiner's complete reasoning in support of the rejections, and to the appellants' appeal brief (Paper No. 10, filed May 5, 1997) and amended

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appeal brief (Paper No. 12, filed July 25, 1997) for the  
appellants' arguments thereagainst.

OPINION

In reaching our decision in this appeal, we have given careful consideration to the appellants' specification and claims and to the respective positions articulated by the appellants and the examiner. As a consequence of our review, we make the determinations which follow.

Before addressing the examiner's rejections, we will initially direct our attention to appellants' independent claims 1, 11 and 18 to derive an understanding of the scope and content thereof.

Claim 1 recites:

In a method of playing a combined card and dice game, the improvement comprising the steps of:

(a) dealing to at least one player at least two cards bearing indicia;

(b) a player rolling at least one die having faces bearing indicia to establish a rolled point; and

(c) permitting a player to improve a rolled point upon achieving a predetermined combination of said indicia of said cards and said at least one die.

Upon reading claim 1 in light of the specification, we interpret "a player" recited in paragraphs (b) and (c) of claim 1 to be the "at least one player" recited previously in paragraph (a) of claim 1. Similarly, upon reading claims 11 and 18 in light of the specification, we interpret "a player" recited in paragraphs (b) and (c) of claims 11 and 18 to be the "at least one player" recited previously in paragraph (a) of claims 11 and 18.

**Rejection under 35 U.S.C. § 112, second paragraph**

We will not sustain the rejection of claims 1 through 20 under 35 U.S.C. § 112, second paragraph, as being incomplete for omitting essential steps, such omission amounting to a gap between the steps.

The second paragraph of 35 U.S.C. § 112 requires claims to set out and circumscribe a particular area with a reasonable degree of precision and particularity. In re Johnson, 558 F.2d 1008, 1015, 194 USPQ 187, 193 (CCPA 1977). In making this determination, the definiteness of the language employed in the claims must be analyzed, not in a vacuum, but

always in light of the teachings of the prior art and of the particular application disclosure as it would be interpreted by one possessing the ordinary level of skill in the pertinent art. Id.

An examiner's focus during examination of claims for compliance with the requirement for definiteness of 35 U.S.C. § 112, second paragraph, is whether the claims meet the threshold requirements of clarity and precision, not whether more suitable language or modes of expression are available. Some latitude in the manner of expression and the aptness of terms is permitted even though the claim language is not as precise as the examiner might desire. If the scope of the invention sought to be patented can be determined from the language of the claims with a reasonable degree of certainty, a rejection of the claims under 35 U.S.C. § 112, second paragraph, is not appropriate.

With this as background, we turn to the specific rejection under 35 U.S.C. § 112, second paragraph, made by the

examiner of the claims on appeal. The examiner's statement of this rejection is as follows:

Claims 1 through 20 are rejected under 35 U.S.C. § 112, second paragraph, as being incomplete for omitting essential steps, such omission amounting to a gap between the steps. See MPEP § 2173.05(1). The omitted steps are for example in claim 1, the steps required by one to permit "a player to improve a rolled point". One cannot perform the claimed invention since one cannot be certain of the steps required. In short, one must look to [the] patent specification and prosecution history since a doubt exists as to scope of claims. With such doubt one cannot clearly determine what applicant regards as his invention. [answer, p. 3]

We agree with the appellants' argument (brief, pp. 9-13) that the claims under appeal do fully apprise those of ordinary skill in the art of the scope of the invention claimed, and thus satisfy the requirement of 35 U.S.C. § 112, second paragraph, to particularly point out and distinctly claim the subject matter which the appellants regard as the invention. In this regard, we note, as did the appellants, that breadth of a claim is not to be equated with indefiniteness. See In re Miller, 441 F.2d 689,, 169 USPQ 597 (CCPA 1971). Additionally, we see no basis for the examiner to conclude that the claims are incomplete for omitting **essential** steps. MPEP § 2173.05(1) cited by the examiner to



support his position no longer exists. However, the second paragraph of MPEP § 2172.01 does state that

a claim which fails to interrelate essential elements of the invention as defined by applicant(s) in the specification may be rejected under 35 U.S.C. 112, second paragraph, for failure to point out and distinctly claim the invention. See *In re Venezia*, 530 F.2d 956, 189 USPQ 149 (CCPA 1976); *In re Collier*, 397 F.2d 1003, 158 USPQ 266 (CCPA 1968).

Nevertheless, the examiner has failed to cite any passage of the specification or in other statements of record that would establish that any **essential** step has been omitted from the claims under appeal. The mere fact that other steps have been disclosed in the preferred embodiment does not render each and every step thereof an **essential** step.

**Rejection under 35 U.S.C. § 112, first paragraph**

We will not sustain the rejection of claims 1 through 20 under 35 U.S.C. § 112, first paragraph, as based on a disclosure which is not enabling.

An analysis of whether the claims under appeal are supported by an enabling disclosure requires a determination of whether that disclosure contained sufficient information regarding the subject matter of the appealed claims as to enable one skilled in the pertinent art to make and use the claimed invention. The test for enablement is whether one skilled in the art could make and use the claimed invention from the disclosure coupled with information known in the art without undue experimentation. See United States v. Telectronics, Inc., 857 F.2d 778, 785, 8 USPQ2d 1217, 1223 (Fed. Cir. 1988), cert. denied, 109 S.Ct. 1954 (1989); In re Stephens, 529 F.2d 1343, 1345, 188 USPQ 659, 661 (CCPA 1976).

In order to make a rejection, the examiner has the initial burden to establish a reasonable basis to question the enablement provided for a claimed invention. See In re

Wright, 999 F.2d 1557, 1561-62, 27 USPQ2d 1510, 1513 (Fed. Cir. 1993) (examiner must provide a reasonable explanation as to why the scope of protection provided by a claim is not adequately enabled by the disclosure). A disclosure which contains a teaching of the manner and process of making and using an invention in terms which correspond in scope to those used in describing and defining the subject matter sought to be patented must be taken as being in compliance with the enablement requirement of 35 U.S.C. § 112, first paragraph, unless there is a reason to doubt the objective truth of the statements contained therein which must be relied on for enabling support. Assuming that sufficient reason for such doubt exists, a rejection for failure to teach how to make and/or use will be proper on that basis. See In re Marzocchi, 439 F.2d 220, 223, 169 USPQ 367, 369 (CCPA 1971). As stated by the court, "it is incumbent upon the Patent Office, whenever a rejection on this basis is made, to explain why it doubts the truth or accuracy of any statement in a supporting disclosure and to back up assertions of its own with acceptable evidence or reasoning which is inconsistent with the contested statement. Otherwise, there

would be no need for the applicant to go to the trouble and expense of supporting his presumptively accurate disclosure."

In re Marzocchi, 439 F.2d at 224, 169 USPQ at 370.

With this as background, we turn to the specific rejection under 35 U.S.C. § 112, first paragraph, made by the examiner of the claims on appeal. The examiner's statement of this rejection is as follows:

Claims 1 through 20 are rejected under 35 U.S.C. § 112, second paragraph, as based on a disclosure which is not enabling. Steps critical or essential to the practice of the invention, but not included in the claim(s) is not enabled by the disclosure. *In re Mayhew*, 527 F.2d 1229, 188 USPQ 356 (CCPA 1976). The scope of the claims goes beyond the scope of the specification. [answer, p. 4]

We agree with the appellants argument (amended brief, pp. 9-11) that the claims under appeal are supported by an enabling disclosure. The dispositive issue is whether the appellants' disclosure, considering the level of ordinary skill in the art as of the date of the appellants' application, would have enabled a person of such skill to make and use the appellants' invention without undue experimentation. The threshold step in resolving this issue,

as set forth supra, is to determine whether the examiner has met his burden of proof by advancing acceptable reasoning inconsistent with enablement. This the examiner has not done.

A claim which omits matter disclosed to be essential to the invention as described in the specification or in other statements of record may be rejected under 35 U.S.C. 112, first paragraph, as not enabling. Mayhew, Id. Such essential matter may include missing elements, steps or necessary structural cooperative relationships of elements described by the applicant(s) as necessary to practice the invention. However, in this case, the appellants have not omitted any matter from the claims under appeal disclosed to be **essential** to the invention as described in the specification or in other statements of record. As set forth previously, the examiner has failed to cite any passage of the specification or in other statements of record that would establish that any **essential** step has been omitted from the claims under appeal. The mere fact that other steps have been disclosed in the

preferred embodiment does not render each and every step thereof an **essential** step.

CONCLUSION

To summarize, the decision of the examiner to reject  
claims 1 through 20 is reversed.

REVERSED

IRWIN CHARLES COHEN	)	
Administrative Patent Judge	)	
	)	
	)	
	)	
	)	BOARD OF PATENT
LAWRENCE J. STAAB	)	APPEALS
Administrative Patent Judge	)	AND
	)	INTERFERENCES
	)	
	)	
	)	
JEFFREY V. NASE	)	
Administrative Patent Judge	)	

GJH

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APJ NASE

APJ COHEN

APJ STAAB

DECISION: **REVERSED**

Prepared By: Gloria Henderson

**DRAFT TYPED:** 29 Oct 98

**FINAL TYPED:**